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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,664	03/08/2004	Donald Bruce Campo	TH-2606 (US)	3145

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EXAMINER

STEPHENSON, DANIEL P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/796,664	Applicant(s) CAMPO, DONALD BRUCE	
	Examiner Daniel P. Stephenson	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/31/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by the WIPO document '199 to Cook et al. WIPO '199 discloses method for providing a casing in a wellbore wherein another casing of the same internal diameter may be provided in the wellbore below the casing. It provides an overlap between the casing and the other casing sufficient to provide a hydraulic seal between the two casings. The method includes the steps of: placing a casing (155) within the wellbore wherein the casing has a smaller outside diameter than a final inside diameter of the casing; placing an expandable mandrel (130,115) within the casing, the expandable mandrel suspended from a drill string; converting the expandable mandrel to a first expansion diameter while the expandable mandrel is within the casing wherein the first expansion diameter is about the final inside diameter plus twice the thickness of the final casing; forcing the expanded mandrel through a lower portion of the casing while the expandable mandrel is of the first expansion diameter; converting the expandable mandrel to a second expansion diameter (115), wherein the second expansion diameter is about the final inside diameter; and forcing the expanded mandrel through an upper portion of the casing while the expandable mandrel is of the second expansion diameter. Converting in this case has been broadly read as preparing the mandrel in a first diameter. The casing is provided with a pre-expanded (135) portion that the mandrel is converted in. There is a cement shoe (140) provided

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on the casing, which is later drilled out. The casing thickness will be determined by the necessities of the formation to be cased and the size of the wellbore drilled.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO '199 in view of the pre-grant publication '433 to Ring et al. WIPO '199 shows all the limitations of the claimed invention, except it does not disclose that the mandrel is expanded through hydraulic force provided by a ^{dart}~~dart~~ that is placed through the tool. Ring et al. '433 discloses the use of a dart to increase the fluid pressure within a expansion tool for hydraulic activation of the expanders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the dart of Ring et al. '433 with the method of WIPO '199. This would be done because it is common knowledge within the downhole tool art to use darts or balls to close off passages for the increase of hydraulic pressure, and to use hydraulically activated expansion tools.

5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO '199 in view of Ring et al. '433 as applied to claim 5 above, and further in view of the pre-grant publication '262 to Musselwhite et al. WIPO '199 in view of Ring et al. '433 shows all the limitations of the claimed invention, except it does not disclose that there is a secondary seal for blocking fluid flow from the drill string. Musselwhite et al. '262 (Figures 8 and 9) discloses a secondary sealing mechanism that is activated by a dart (paragraph 42) downhole that includes a plurality of flapper valves. The valves are not exposed to the fluids flow previous to the

activation using the dart. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the flapper valves of Musselwhite et al. '262 with the apparatus of WIPO '199 in view of Ring et al. '433. This would be done to provide a more robust seal to the flow of fluid.

Allowable Subject Matter

6. Claims 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 1/9/06 have been fully considered but they are not persuasive.

8. It is the assertion of the applicant the WIPO '199 does not disclose that the mandrel is not converted to a first diameter while it is within the casing *after* it is placed within the wellbore. The examiner notes that while the method steps are listed in a certain order in the claim, that order is not necessarily the order which they must be performed in unless there are transitional terms such as "then", "after", "before" etc. In the present case, it is not stated in the claim that the mandrel is converted to a first diameter after it is placed within the wellbore. It is merely stated that the mandrel is converted to a first diameter within the casing. This step may be performed outside the wellbore, prior to the casing being inserted.

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., converting the

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mandrel within the wellbore) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Stephenson whose telephone number is (571) 272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

DPS

